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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,982	12/21/2001	Andreas Engelsberg	10191/1974	6682
26646	7590	04/04/2006	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			VILLECCO, JOHN M	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,982

Applicant(s)

ENGELSBURG, ANDREAS

Examiner

John M. Villecco

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments, see pages 12-13 of the applicant's response, filed February 3, 2006, with respect to the rejection(s) of claim(s) 14-37 under 112, 1st paragraph have been fully considered and are persuasive. The examiner agrees with the applicant's assertion that not enough discussion was given to the 112, 1st paragraph rejection in the previous office action. In accordance with the MPEP § 2164.04, a further discussion of the 112, 1st paragraph rejection focusing on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation is needed. Since the best case for the 112, 1st paragraph rejection was not presented in the previous office action in accordance with the principle of compact prosecution, *this office action is non-final*. The examiner apologizes for the delay in prosecution.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 14-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

More specifically, in accordance with MPEP § 2164, the examiner has the initial burden of establishing a prima facie case of lack of enablement. The question posed when making a lack of enablement rejection is: Is the experimentation needed to practice the invention undue or unreasonable? See *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916). The test for lack of enablement was established in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) and set forth several factors which must be considered by the examiner when making a determination of lack of enablement. These factors can be found in MPEP § 2164.01(a). Furthermore, the examiner need not discuss every factor. The examiner need only to focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation.

B) The nature of the invention

This invention is directed toward a method of determining the displacement of images in an image sequence. More specifically, the invention is directed toward using a probability of image movement occurring and using that probability of image movement to specify and fix a position and dimensions of the plurality of image regions.

C) The state of the prior art

After a thorough prior art search a determination has been made that a lot of work has been done in determining a displacement of images in an image sequence, but no prior art has been found that uses a probability of image movement occurring without additional movement to specify and fix a position and dimension of image regions. The closest prior art that has been

Art Unit: 2622

found is the Egusa reference (U.S. Patent No. 5,237,405) which uses a reliability factor to judge the degree of correlation. However, as mentioned in the applicant's response filed August 11, 2005, the reliability determination of Egusa cannot be interpreted to be a probability.

D) The level of one of ordinary skill in the art

The examiner is of the opinion that it is well known in the art to determine a movement within an image from the background of the image, but one of ordinary skill in the art would not have known how to calculate a probability and then use that probability to specify and fix a position and dimensions of the image regions. Proof of this lies in the fact that no prior art has been found that uses a probability to determine set the position and dimensions of the image regions.

F) The amount of direction provided by the inventor

In the specification the concept of probability is only mentioned a couple of times. Further, there is no description of how the probability is calculated or how that probability is used to specify and fix the position and dimensions of the image region. A probability is mentioned on page 1, line 27 of the substitute specification and page 14, lines 11-19. However, these sections do not elaborate on how the probability is calculated or used in the present invention. On page 14, lines 11-19, the inventor merely states that "the probability of the image movement occurring at various positions of the images of an image sequence without the additional movement is determined." The inventor also states that "this results in preferential portions inside the image which can be used for separating the image movement from the

Art Unit: 2622

additional movement.” However, this appears to be the only detail that is given on the determination of a probability. One of ordinary skill in the art would not be enabled to make and or use a probability to specify and fix a position and dimension of the image regions.

G) The existence of working examples

There is no mention of a working example, nor any example of using a probability to specify and fix a position and dimension of the image regions in any of the prior art.

H) The quantity of experimentation needed based on the disclosure

Since using a probability to specify and fix a position and dimension of the image regions does not appear to be something that has been used before, the disclosure should be enabling enough for one of ordinary skill in the art to make and/or use the invention. As mentioned previously, the only mentioning of probability occurs on page 1, line 27 of the substitute specification and page 14, lines 11-19. However, these sections do not elaborate on how the probability is calculated or used in the present invention. One of ordinary skill in the art would have to engage in undue experimentation in order to figure out how to use a probability to specify and fix a position and dimensions as a function of the probability. Therefore, since the specification provides no detail on how to calculate the probability or how to use the probability to specify and fix the dimensions and positions of the image regions, the disclosure is non-enabling. See MPEP § 2164.06.


Art Unit: 2622

For the reasons discussed on the previous pages, the examiner maintains that claims 14-37 are non-enabled in view of the specification.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (571) 272-7319. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John M. Villecco
March 29, 2006



DAVID OMETZ
SUPERVISORY PATENT EXAMINER